

R E M A R K S

Submitted herewith is a Facsimile copy of a Declaration under 37 C.F.R. §1.132 by the joint applicant Tohru Yashiro.

Claims 1 - 5 have been cancelled, to expedite prosecution, but without prejudice to the scope of protection to which applicants are believed to be entitled. Claim 6 has been amended to include the recitals of original dependent claim 12 (which has accordingly been cancelled as redundant, with claim 13 made dependent on 6) and to specify that the content of the formazan-metal chelate compound in the recording layer is from 20% by weight to 40% by weight. The latter recital is supported by the disclosure of the original specification at p. 28, second line from the bottom, to p. 29, line 2. Since this Amendment does not increase either the total number of claims or the number of independent claims, no additional fee is necessary.

Claims 6 (independent; amended), 7 - 11 (directly or indirectly dependent on 6) and 13 - 20 (directly or indirectly dependent on 6), all directed to an optical recording medium, are in the application. No claim has been allowed.

All grounds of rejection of claims 1 - 5 are mooted by the cancellation of those claims herein.

The rejection of claims 6 - 11 and 14 - 20 under 35 U.S.C. §102(b) as anticipated by EP 1267338 (Noguchi et al. '338) is overcome by the amendment of claim 6 (on which claims 7 - 11 and 14 - 20 are dependent) to include the recitals of now-cancelled claim 12, which was not rejected as anticipated by Noguchi et al. '338. The feature recited in original claim 12, now added to amended claim 6, is not taught by Noguchi et al. '338.

The rejection of claims 6 - 11 and 14 - 20 under 35 U.S.C. §103(a) as unpatentable over Noguchi et al. '338 in view of EP 1132902 (Noguchi et al. '902) and JP 2000-343821 (Kanbe et al.) is

likewise overcome by the aforesaid amendment of claim 6 adding a recital of the feature originally claimed in claim 12. Noguchi et al. '338, Noguchi et al. '902 and Kanbe et al., considered together as the Examiner proposes, do not even assertedly make obvious the combination of the feature of claim 12 with the limitations of original claim 6.

The sole remaining ground of rejection is the rejection of claims 6 - 20 under 35 U.S.C. §103(a) as unpatentable over Noguchi et al. '338 in view of Noguchi et al. '902 and Kanbe et al., further in view of EP 1335357 (Noguchi et al. '357).

In this regard, attention is respectfully directed to the aforementioned Declaration under 37 C.F.R. §1.132 attached hereto, and to the amendment of claim 6 herein to specify that the defined formazan-metal chelate compound is present in the recording layer in a content of 20% by weight to 40% by weight. These limits are not taught in the references.

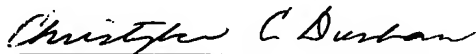
In the Declaration, additional experimental data is provided to evidence that, when the content of the formazan-metal chelate compound in the recording layer is from 20% by weight to 40% by weight, the optical recording medium of the present invention enables good optical properties before (initial values) and after the light resistance test.

Moreover, concerning a squarylium-metal chelate compound (a-M-b) including at least two squarylium dye ligands ("a" and "b") which are different from each other and the technical effects obtainable thereby, applicant submits that the compound a-M-b of the present invention has resulted in improvement in its solubility in the solvent, as compared with a squarylium-metal chelate compound with all the ligands being the same. This allows for preventing the coating film defects caused by deposition of dye crystal during spin-coating.

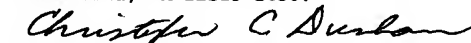
Thus, the specific combination of limitations now set forth in amended claim 6, on which claims 7 - 11 and 13 - 20 depend, affords important beneficial results. It is submitted that even if Noguchi et al. '338 in view of Noguchi et al. '902, Kanbe et al. and Noguchi et al. '357, could be deemed to make *prima facie* obvious the combination of features defined in amended claim 6 (which applicants do not concede), nevertheless the beneficial results achieved would not have been expected from the references, and as such are entitled to patentable weight, distinguishing claim 6 and the dependent claims 7 - 11 and 13 - 20 patentably over the applied references.

For the foregoing reasons, it is believed that this application is now in condition for allowance. Favorable action thereon is accordingly courteously requested.

Respectfully,


Christopher C. Dunham
Reg. No. 22,031
Attorney for Applicants
Tel. (212) 278-0400

I hereby certify that this paper is being deposited this date with the U.S. Postal Service as first class mail addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.


Christopher C. Dunham, Reg. No. 22,031
Date: NOVEMBER 1, 2006